Boehringer Ingelheim

To: Commissioner for Patents

Boehringer Ingelheim Corporation

Date: December 14, 2004

Fax: 703-872-9306

No. of Pages including cover sheet: 4

RE: **13/112**

Enclosed is a response to an office action dated November 16, 2004.

Thank you,
Linda Boland-Covey

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:	Murray D. Bailey, et al.)	Art Unit:	1654
Serial No.:	10/791,318)	Examiner:	T. Heard
Conf. No.:	1817)		
Filed:	03/02/2004		
For:	Hepatitis C Inhibitor Peptide Analogs		
Docket No.:	13/112		

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

RESPONSE

Sir:

This is in response to the Office Action dated November 16, 2004, setting forth a 1 month period for reply. At page 2 of the office action, the examiner sets forth a restriction requirement in 4 groups:

I. Claims 1-30 and 46, drawn to a composition
II. Claims 31-38, drawn to a method of Hepatitis C treatment
III. Claim 39, drawn to a process of making a composition
IV. Claims 40-45, drawn to a succinate composition

At page 5, the examiner also requires an election of species if either Group I or II is elected.

In response, Applicants herein elect Group I, with compound 12 in Table 1 as the elected species. Claims 1-18, 20-39 and 46 read upon this elected species, or its method of use or method of synthesis. This election is made with traverse.

Applicants traverse the restriction requirement for the following reasons:

1. In arguing for distinction between Groups I and III, the examiner argues that the product of claim 1 could be made in a different manner by using different protecting groups, or by combining different starting materials that would arrive at the identical compound via a different

strategy. However, the examiner does not provide any documentary or other evidence to support this argument.

2. In arguing for distinction between Groups I and IV, the examiner argues that the intermediate product is deemed to be useful as an intermediate in the synthesis of Nonactin. However, the examiner does not provide any documentary or other evidence to support this argument.

3. In arguing for distinction between Groups III and IV, the examiner argues that the composition of group IV can be used as a reagent in the synthesis of structurally different compounds, and that the compound of IV is not needed to practice the method of III and the method of group III is not needed to make or use the product of IV. However, the examiner does not provide any documentary or other evidence to support these arguments. Further, the intermediate II as claimed in group IV is the same intermediate II used as a reactant in group III. Thus, the examiner's statement that the compound of IV is not needed to practice the method of III is incorrect.

For the foregoing reasons, Applicants respectfully submit that the restriction requirement is improper and should be withdrawn.

Applicants also traverse the election of species requirement. Applicants submit that, at the very least, the compounds of formula (I) as depicted in claim 1 constitute a proper Markush Group of compounds as they all share a common substantial structural core and all share a common utility as HCV NS3 protease inhibitors useful for treating HCV infection. Accordingly, Applicants elect a single disclosed species herein on the understanding that this is done only to facilitate initial search and examination, but that this application will be generically examined in according with the USPTO's Markush Practice as outline in MPEP 803.02 in the event that the elected species is found to be patentable.

Applicants appreciate the Examiner's acknowledgment (at pg. 6 of the Office Action) that the USPTO's Rejoinder Practice (MPEP 821.04) is applicable to the present application. In the event that the product claims of Group I are found to be allowable, Applicants request that the process (method) claims of Groups II and III be rejoined in the examination under Rejoinder Practice since all these process claims depend from the product claims of Group I.

RESPONSE
US APPLN. NO. 10/791,318

In view of the above remarks, Applicants respectfully submit that this application is now in condition for early examination. If any points remain at issue which can best be resolved by way of a telephonic or personal interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

Respectfully submitted,

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Certificate of Transmission
I hereby certify that this correspondence is being facsimile transmitted to the US Patent and Trademark Office to: fax # (703) 872-9306 on December 14, 2004.

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